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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/438,104	11/10/1999	ASGEIR SAEBO	CONLINCO-040	8881

23535 7590 08/28/2003

MEDLEN & CARROLL, LLP  
101 HOWARD STREET  
SUITE 350  
SAN FRANCISCO, CA 94105

EXAMINER
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JONES, DWAYNE C

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 08/28/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicant(s)

09/438,104

Applicant(s)  
SAEBO ET AL.

Examiner

Dwayne C Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 21.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 7-24 are pending.
2. Claims 7-24 are rejected.

### ***Response to Arguments***

3. Applicant's arguments filed May 30, 2003 have been fully considered but they are not persuasive. Applicants make the following arguments. First, applicants argue that one skilled in the art would recognize the composition obtained by Cain et al. necessarily contains other isomers than 9,11 and 10,12 isomers of conjugated linoleic acid (CLA). Second, applicants argue that since Pariza et al. do not teach of 10,12-octadecadienoic acid, a prima facie case of obviousness has not been established.

4. Applicants first argue that one skilled in the art would recognize the composition obtained by Cain et al. necessarily contains other isomers than 9,11 and 10,12 isomers of conjugated linoleic acid (CLA). This argument is found unpersuasive. The instant claims are only directed to product claims, which contain at least 50% 9,11-octadecadienoic acid and 10,12-octadecadienoic acid and less than 1% of 11,13-octadecadienoic and 8,10-octadecadienoic acid isomers. The prior art reference of Cain et al., just like the instant claims, teach of the product of conjugated unsaturated fatty acid, namely linoleic acid, that has "91.8" of conjugated linoleic acid (CLA) of which 49.7% was the 9,11-isomer and 50.3% was the 10,12-isomer, (see page 11, lines 14-17). In addition, Cain et al. specifically teach that the cis-9, trans-11 and trans-10,cis-12 are the most abundant isomers, (see page 1, lines 8-22). Furthermore, the instant

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claims are not limited to any particular geometric isomers so the arguments regarding the Sugano et al. reference are not germane.

5. Second, applicants argue that since Pariza et al. do not teach of 10,12-octadecadienoic acid, a prima facie case of obviousness has not been established. Pariza et al. disclose of the following that, "[o]f the various positional and geographic isomers present in CLA, the cis-9,trans-11 isomer is believed to be an active form. . . . In processed plant oils about 42% of the isomers were in the cis-9, trans-11 configuration and another 42% were in the trans-10,cis-12 configuration, as was the case in CLA prepared from chemically from linoleic acid.", (see column 2, lines 50-58). Clearly, Pariza et al. teach of a product, namely plant oil, which contains over 84% of the isomers were in the cis-9, trans-11 configuration and in the trans-10,cis-12 configuration, which makes the instantly claimed invention obvious.

#### ***Information Disclosure Statement***

6. The information disclosure statement filed on May 30, 2003 has been reviewed and considered, see enclosed copy of PTO FORM 144.

#### ***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. The rejection of claims 7-24 under 35 U.S.C. 103(a) as being unpatentable over Cain et al. of WO 97/18320 is maintained and repeated. Cain et al. teach of

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compositions of conjugated linoleic acid that are used in food products for both animals and humans, (see page 1). Cain et al. teach of a 91.8% conjugated linoleic acid product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer, (see Example 1). In addition, Cain et al. teach of alkyl esters of these conjugated linoleic acids (see Examples 1 and 3) as well as conjugated linoleic acid triglycerides, (see Example 8). Cain et al. also teach of utilizing the characterization method of HPLC as well as GC (see Example 8). Although Cain et al. do not specifically discuss peak area percentages of the isomers of 11,13-octadecadienoic and 8,10-octadecadienoic acid, it would have been obvious to one having ordinary skill in the art that these isomers would be less than 1% of a peak area because Cain et al. teach of a conjugated linoleic acid composition product of which 49.7% was the cis 9, trans 11-isomer and 50.3 % was the trans 10, cis 12-isomer. Accordingly, Cain et al. teach of a composition which contains a total of 100 % of both the isomers of cis 9, trans 11-isomer and which would obviously exclude the isomers of 11,13-octadecadienoic and 8,10-octadecadienoic acid. In addition, Cain et al. teach of utilizing the characterization method of HPLC as well as GC, which are known to present data results of analyzed products as percentages based on peak areas. Accordingly, it would have been obvious to one having ordinary skill in the art to express the isomers of conjugated linoleic acid as peak area percentages especially when the prior art reference of Cain et al. teach of using the characterization techniques of HPLC and GC, (see the Examples of Cain et al.).

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9. The rejection of claims 7-24 under 35 U.S.C. 103(a) as being unpatentable over Pariza et al. of U.S. Patent No. 5,856,149 is maintained and repeated. Pariza et al. disclose that it is known in the art that conjugated linoleic acid is recognized as a nutritional supplement for mammals, (see column 1). Pariza et al. also disclose of a fatty acid composition, which contains more preferably between 98 and 99% of the cis-9, trans-11 isomers of 18 carbon fatty acids. Pariza et al. further disclose that the negligible remainder of the isomers produced are cis-9, cis-11 and trans-9, trans-11 isomers of conjugated linoleic acid, (see column 4, lines 24-35). In addition, Pariza et al. teach that these conjugated fatty acids may be free or bound chemically through ester linkages, (see column 4, lines 54-56). Since Pariza et al. teach of compositions, which contain up to 99% of cis-9, trans-11 isomers of conjugated linoleic acid and that "[t]he negligible remainder of the isomers produced are cis-9, cis-11 and trans-9, trans-11 configuration", it would have been obvious to the skilled artisan that this would result in a composition which contains well over 50% of conjugated linoleic acid, specifically 99%, and less than 1% of other negligible isomers of conjugated linoleic acid that would embrace all other isomers of 9,11- and 10,12 conjugated linoleic acid as well as other negligible isomers, such as 11,13-octadecadienoic and 8,10-octadecadienoic acid. It is further pointed out that Pariza et al. also teach of utilizing the characterization method of HPLC as well as GC, which are known to present data results of analyzed products as percentages based on peak areas. Accordingly, it would have been obvious to one having ordinary skill in the art to express the isomers of conjugated linoleic acid as peak

area percentages especially when the prior art reference of Pariza et al. teach of using the characterization techniques of HPLC and GC, (see columns 7-10).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

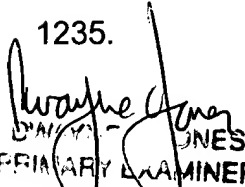
Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. C. Jones whose telephone number is (703) 308-4634. The examiner can normally be reached on Mondays through Fridays from 8:30 am to 6:00 pm. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-

1235.

  
WAYNE JONES  
PRIMARY EXAMINER

Tech. Ctr. 1614

August 27, 2003